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REMARKS

Applicant has carefully studied the office action of April 5, 2006 and offers the following remarks.

Before addressing the rejections, Applicant provides a brief summary of the present invention so that the remarks relating to the rejections are considered in the proper context. The present invention is a portable device that the user carries and selectively couples to a host computer. Once the portable device is coupled to the host computer, software applications are launched on the host computer as a function of automatically executing software on the portable device. One of the applications is a web browser. Another function of the present invention is to push content to the user. Content is provided to the user through an interface frame. The interface frame is similar to a "window" that is distinct from the browser, rides on top of the browser, and may lie on top of the normal task bar that is present at the top of a browser window (see Figs. 5 and 6). The interface frame has a spot in which the content can be displayed. Likewise, the browser displays other content like a conventional browser.

It is important to note that the present invention is designed to function independently of the current status of the computer. That is, the current invention allows the portable device to be inserted into the computer and automatically executes the software without requiring the computer to change states, and in particular, the present invention does not require the computer to boot or reboot. As booting the computer is a disruptive and time consuming process, the lack of a requirement to boot or reboot the computer provides an advantage over Paul, which explicitly requires booting the computer.

Claim 41 was rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The Patent Office objects to the "without requiring the host computing device to reboot" in claim 41, arguing that this negative limitation is not supported in the original disclosure. Applicant respectfully traverses. Applicant maintains its position as set forth in its previous response (Response mailed January 17, 2006, pp. 9-10). In general, negative limitations are not ambiguous, and negative limitations are now an accepted form of claim drafting despite earlier concerns by the courts. MPEP § 2173.05(i). MPEP § 2173.05(i) goes on to state "a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support." *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993)." Applicant notes that the specification never mentions

rebooting the host computing device as a precondition to operation of the invention. Since booting and rebooting are the exceptions to the norm, the absence of a discussion of the boot requirements in Applicant's specification indicates that Applicant's invention functions normally and does not require a boot or reboot. In short, the negative limitation is supported in the specification. Applicant requests withdrawal of the § 112 rejection of claim 41 at this time.

Claims 1, 5-7, 9, 12-15, 17, 21-23, 25, 28, 29, 33-35, 37, and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul (USP 5,954,808), Nulu (USP 6,650,347) and Krishan et al. (USP 6,442,529). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Once a proper combination has been made, to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is shown. MPEP § 2143.03.

Applicant is aware that most inventions are combinations of known elements. One of the things that makes an invention patentable is that there was no suggestion to combine the known elements in the manner claimed. To avoid impermissible hindsight reconstruction, the Federal Circuit, in *Dembiczak*, acknowledged earlier case law that set forth various sources from which a suggestion to combine references may come, but reiterated that the range of available sources does not diminish the requirement for actual evidence. *In re Dembiczak* at 999. In the present application, the Patent Office has not complied with the requirements set forth by the Federal Circuit.

Specifically, the Patent Office asserts that the motivation to combine Paul and Krishan is "to enable Paul's system to display advertisements on user's screen." (Office Action of April 5, 2006, page 4). Applicant had previously argued that this asserted motivation lacks the required actual evidence and that the proposed motivation does not compel the combination (Response mailed January 17, 2006, p.11). The Patent Office does not substantively address Applicant's arguments, instead just dismissing them as not persuasive (Office Action mailed April 5, 2006, p. 7). The Patent Office then states that Paul and Krishan are in the same field of endeavor and repeats the alleged motivation to combine. Just because the references are in the same field of endeavor does not provide a motivation to combine. The Patent Office has still

failed to provide any evidence to support the alleged motivation, as required by applicable Federal Circuit case law. *In re Dembiczak* at 999. Moreover, the Patent Office failed to rebut Applicant's arguments that the proposed motivation to combine Paul and Krishan does not suggest the combination. Specifically, Paul is a set top box for a television (see Paul Figure 1). Televisions almost always display advertisements. Certainly broadcast channels are replete with advertisements. Even cable channels such as HBO, CNN, and ESPN show advertisements. Thus, there is no need to add Krishan to Paul to allow Paul's system to display advertisements on the user's screens. Applicant respectfully maintains that the combination of Paul and Krishan is improper because the proposed motivation to combine is improper and the combination is not compelled by the alleged motivation.

In addition, the Patent Office now attempts to add Nulu to the combination of Paul and Krishan without providing the requisite evidence to support the motivation to combine these three references. The Patent Office argues the motivation to combine Paul and Nulu is "to enable the user to easily modify the configuration of the system." (Office Action mailed April 5, 2006, p. 4). Once again, the Patent Office has failed to provide the required actual evidence to support the proposed motivation to combine. In addition, Paul is already directed to configuring a computer based system; the Patent Office has not provided any rationale, or evidence in support of such rationale, why Paul would need to look to Nulu. Since the Patent Office has failed to provide any actual evidence to support the stated motivation to combine, and the stated motivation to combine is not even necessary, the motivation to combine does not suggest the combination and the combination of references is improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

Applicant still further traverses the rejection because the Patent Office has not established *prima facie* obviousness. Specifically, the combination, even if proper (a point Applicant does not concede), does not show an interface frame associated with a portable device as recited in the independent claims. Claim 1 recites "the software adapted to automatically execute on the host computing device in association with a computing session and provide an interface frame associated with the portable device on a display of the host computing device." The Patent Office asserts that Nulu shows the interface frame at col. 13, lines 55 through col. 14, line 13, which is claim 1 of Nulu. Claim 1 of Nulu is directed to a GUI having a resource tree window, a maintenance menu and a configuration window that does not overlap the resource tree. Nowhere

in Nulu is there an interface frame mentioned. In addition, Nulu does not disclose a portable device having software that automatically executes on a host computing device. The card inserted into a hardware box in Nulu is as far from a portable device as is technically possible. The card in Nulu is a typical line card in a typical hardware equipment that is plugged into a connector of a backplane through which various cards communicate (Nulu, col. 3, lines 57-65). The card of Nulu is not a portable device. Since there is no portable device, there can be no interface frame associated with a portable device, as required by the claim. Moreover, the interface frame of the present invention frame has a spot in which the content can be displayed; it is similar to a "window" that is distinct from the browser, rides on top of the browser, and may lie on top of the normal task bar that is present at the top of a browser window (see Figs. 5 and 6). Nulu does not disclose such an interface frame. Nothing in Nulu displays content like the interface frame of the present invention; neither the resource tree window, the maintenance tree, nor the configuration frame of Nulu rides on top of, but is distinct from a browser. The configuration window of Nulu does not even overlap the resource tree. It is clear from reading Nulu that Nulu does not teach or suggest providing "an interface frame associated with the portable device on a display of the host computing device," as required by the independent claims. Krishan and Paul do not cure the deficiencies of Nulu. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element, and the Patent Office has not established obviousness. Applicant requests withdrawal of the § 103(a) rejection at this time.

Applicant maintains its arguments with respect to the rejection of claims 11, 27, and 39 under 35 U.S.C. § 103(a) as being unpatentable over Paul, Krishan and Hendrick as set forth in its previous response (Response mailed January 17, 2006, p. 12). Likewise, Applicant refers the Patent Office to its arguments in the January 17, 2006 Response with respect to the rejections of claims 2-4, 16, 18-20, and 30-32 (Response mailed January 17, 2006, pp. 12-13). The combination of Paul, Krishan, and Nulu, even if proper, does not teach or suggest each and every limitation of the independent claims. None of the other references cure the deficiencies of the Paul/Krishan/Nulu combination. Therefore, all pending claims are allowable.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. The references are not properly combined and do not teach the interface frame recited in the claims. Applicant earnestly solicits claim allowance at the Examiner's earliest opportunity.

Respectfully submitted,

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